PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	BERG, Hakan; et al.	Group Art Unit:	3772
Serial No.:	10/711,894	Confirmation No.	5893
Date Filed:	October 12, 2004	Examiner:	PATEL, Nihir B.

For: METHOD AND ARRANGEMENT FOR SCAVENGING ESCAPE GAS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REFUND UNDER 37 C.F.R. § 1.26

Applicants hereby request a refund of $760, which is the sum of the $270 small entity Notice of Appeal fee and the $490 difference between one month extension of time (earlier paid) and the three month extension of time required to file the Notice of Appeal. Applicants are making this request because the Examiner failed 1) to follow the M.P.E.P. requirements for after-final handling of papers filed with the Office and 2) to respond to multiple telephone messages Applicants' undersigned representative left for him. Had the Examiner acted in timely fashion as required by the M.P.E.P. or responded to Applicants' representative's telephone messages, there would have been no need to file the Notice of Appeal. Accordingly, the $760 Applicants were required to pay is in excess of that which should have been required, and Applicants request that it be refunded.[1]

* * * * *

On June 10, 2008, the Office issued a Final Office Action. Various claims were rejected; other claims, however, were objected to as depending from rejected base claims but were otherwise indicated to be directed to allowable subject matter.

On August 8, 2008, Applicants filed an Amendment in response to the Final Office Action. Applicants amended the claims, but not so much as to limit them to the subject matter that had been indicated to be allowable. Applicants argued that the amended claims should have been allowable over the art of record.

On September 5, 2008, the Office issued an Advisory Action. According to the Advisory Action, Applicants' amendments and argument did not overcome the Examiner's rejections.

On September 19, 2008, Applicants filed a Supplemental Amendment in further response to the Final Office Action. Applicants paid for one month extension of time to do so (via authorization to charge a Deposit Account). In the Supplemental Amendment, Applicants amended the independent claims to incorporate all features of certain respective dependent claims that had been indicated to be directed to allowable subject matter. Therefore, the Supplemental Amendment presumably placed the application in condition for allowance.

According to M.P.E.P. § 714.13 (underscoring added, italics in original),

> Any amendment timely filed after a final rejection should be immediately considered to determine whether it places the application in condition for allowance or in better form for appeal. An examiner is expected to turn in a response to an amendment after final rejection within 10 calendar days from the time the amendment is received by the examiner. A reply to an amendment after final rejection should be mailed within 30 days of the date the amendment is received by the Office. In *all* instances, both before and after final rejection, in which an application is placed in condition for allowance, applicant should be notified promptly of the allowability of the claims by a Notice of Allowability form PTOL-37. If delays in processing the Notice of Allowability are expected, e.g., because an extensive examiner's amendment must be entered, and the end of a statutory period for reply is near, the examiner should notify applicant by way of an interview that the application has been placed in condition for allowance, and an Examiner Initiated Interview Summary PTOL-413B should be mailed. Prompt notice to applicant is important because it may avoid an unnecessary appeal and act as a safeguard against a holding of abandonment. Every effort should be made to mail the letter before the period for reply expires.

[1] Under 37 C.F.R. § 1.26(a), "[t]he Director may refund any fee paid by mistake or in excess of that required."

Continuing to see the Final Office Action on his docket and expecting to have received a Notice of Allowability by the end October 2008 at the latest, Applicants' undersigned representative called the Examiner to inquire into the status of the application; not reaching the Examiner, Applicants' representative left a voice mail message for the Examiner asking him to return the call.[2] Applicants' representative did this several times through November 2008, but to no avail. Having received no response from the Examiner, Applicants' representative called the Examiner's SPE; not reaching her, either, Applicants' representative left voice mail messages for her, too, but also to no avail.

On December 10, 2008 – i.e., the last day of the six-month statutory period for taking action in response to the Final Office Action – Applicants' undersigned representative yet again called the Examiner and the SPE and left messages for both; yet again, neither responded. Therefore, not having received any further communication from the Office and to prevent the application from becoming abandoned, Applicants were forced to file a Notice of Appeal and pay for two more months of extension to be able to do so.

On December 11, 2008, the Examiner finally returned the undersigned representative's phone calls. According to the Examiner, the Supplemental Amendment had not been placed on his docket in eDan, so he did not know there was any Supplemental Amendment on which to act. That excuse "does not wash" for several reasons. First, Applicants' representative specifically indicated in the voice mail messages that Applicants had filed a further reply with the Office and needed to know the status of the application. Second, according to the transaction history available online in PAIR, the Supplemental Amendment was forwarded to the Examiner on October 23, 2008 (which was after the date Applicants should have received something in response to it). Therefore, the Examiner should have been "expected to turn in a response" by November 2, 2008. Third, even if the Supplemental Response was not, in fact, put on the Examiner's docket, had he returned any of the multiple phone calls in timely fashion, he clearly would have learned there was an Amendment on which he needed to act; he could have done so

[2] The Examiner's voice mail greeting promises to return calls within no later than one business day.

in adequate time before the end of the six-month statutory period; and the need for Applicants to file the Notice of Appeal – at a cost to Applicants of $760 – would have been avoided.[3]

In view of the foregoing, Applicants submit that they are entitled to a refund. Applicants paid the $760 by credit card; therefore, Applicants request that that amount be credited to the account against which the fees were charged.

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[3] Applicants' representative made this point to the Examiner. The Examiner had no response.